Remarks

The Office Action mailed October 25, 2004, has been carefully reviewed and the foregoing amendment has been made in consequence thereof.

Claims 1-20 are now pending in this application. Claims 1-20 stand rejected.

The rejection of Claims 1-3, 7, 8, 10, 12, and 16-20 under 35 U.S.C. § 102(b) as being anticipated by Horejsi (US 5,239,487) is respectfully traversed.

Horejsi describes a manufacturing rework station (100) and method. The station is integrated with a computer (114) that includes a repair cell program (300). The repair cell program functions as an interface between a rework station operator, one or more databases (310-314), and one or more knowledge bases (320). The computer is connected via a communication cable (115) to a local area network (200). The repair cell provides the operator with a graphical environment which aids in the diagnosis and repair of defects. The databases contain manufacturing history for each individual article. In response to the operator selecting an article, the computer displays the possible diagnoses and repair actions associated the article. Notably, Horejsi does not describe a repair cell that recommends a repair sequence of steps necessary to effectuate a repair action, but rather Horejsi describes a repair actions in general. Moreover, Horejsi does not describe nor suggest providing error proofing directions.

Claim 1 recites a method for distributing information concerning recommended steps for repairing a part, comprising "using a computer network to receive at a first location a request for a recommended repair sequence of steps for repairing the part, the request originating at a second location that is remote from the first location...processing, at the first location, the request to produce the recommended repair sequence of steps for repairing the part...determining the recommended repair sequence of steps and providing error proofing directions...and using the computer network to convey from the first location to the second location a response that includes the recommended repair sequence of steps for repairing the

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part and error proofing directions based on the recommended repair sequence of steps included in the response."

Horejsi does not describe nor suggest a method for distributing information concerning recommended steps for repairing a part, wherein the method includes using a computer network to receive at a first location a request for a recommended repair sequence of steps for repairing the part, the request originating at a second location that is remote from the first location, processing, at the first location, the request to produce the recommended repair sequence of steps for repairing the part, determining the recommended repair sequence of steps and providing error proofing directions, and using the computer network to convey from the first location to the second location a response that includes the recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps included in the response. Specifically, Horejsi does not describe nor suggest providing error proofing directions. Rather, and in contrast to the present invention, Horejsi describes a repair action in general terms without providing error proofing directions. Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Horejsi.

Claims 2-9 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-9 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-9 likewise are patentable over Horejsi.

Claim 10 recites a method for distributing information concerning recommended steps for repairing a part, where in the method comprises "providing a computer network for communicating digital data between at least two locations...first conveying, using the computer network, a request for a recommended repair sequence of steps for repairing the part, the request having originated at a first location and being directed to a second location...and second conveying, in response to the request and using the computer network, a response that includes the recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps included in the response, the response having originated at the second location and being directed to the first location."

Horejsi does not describe nor suggest a method for distributing information concerning recommended steps for repairing a part, wherein the method includes providing a computer network for communicating digital data between at least two locations, first conveying, using the computer network, a request for a recommended repair sequence of steps for repairing the part, the request having originated at a first location and being directed to a second location, and second conveying, in response to the request and using the computer network, a response that includes the recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps included in the response, the response having originated at the second location and being directed to the first location. Specifically, Horejsi does not describe nor suggest providing error proofing directions. Rather, and in contrast to the present invention, Horejsi describes a repair action in general terms without providing error proofing directions. Accordingly, for at least the reasons set forth above, Claim 10 is submitted to be patentable over Horejsi.

Claims 13-15 depend, directly or indirectly, from independent Claim 10. When the recitations of Claims 13-15 are considered in combination with the recitations of Claim 10, Applicants submit that dependent Claims 13-15 likewise are patentable over Horejsi.

Claim 16 recites a method for providing information concerning recommended steps for repairing a part, wherein the method comprises "providing, in a computer memory, a decision tree having at least two possible sequences of steps for repairing a part and error proofing directions based on the sequences of steps…receiving a request, originating from a computer input device, for a recommended repair sequence of steps for repairing the part…using, in a digital computer, the decision tree to determine a recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps…and transmitting the recommended repair sequence of steps and the error proofing directions towards a computer output device."

Horejsi does not describe nor suggest a method for providing information concerning recommended steps for repairing a part, wherein the method includes the steps of providing, in a computer memory, a decision tree having at least two possible sequences of steps for

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repairing a part and error proofing directions based on the sequences of steps, receiving a request, originating from a computer input device, for a recommended repair sequence of steps for repairing the part, using, in a digital computer, the decision tree to determine a recommended repair sequence of steps for repairing the part error proofing directions based on the recommended repair sequence of steps, and transmitting the recommended repair sequence of steps and the error proofing directions towards a computer output device. Specifically, Horejsi does not describe nor suggest a method for providing error proofing directions. Rather, and in contrast to the present invention, Horejsi describes a repair action in general terms without providing error proofing directions. Accordingly, for at least the reasons set forth above, Claim 16 is submitted to be patentable over Horejsi.

Claims 17-20 depend, directly or indirectly, from independent Claim 16. When the recitations of Claims 17-20 are considered in combination with the recitations of Claim 16, Applicants submit that dependent Claims 17-20 likewise are patentable over Horejsi.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 102 rejection of Claims 1-10 and 13-20 be withdrawn.

The rejection of Claims 4-6, 9, 11, and 13-15 under 35 U.S.C. § 103(a) as being unpatentable over Horejsi as applied to Claims 1, 7, and 10 above, and further in view of Hart et al. ("Hart") (US 6,295,525) is respectfully traversed.

Horejsi is described above. Hart describes a system (10) for automatically invoking computational resources (308) without intervention or request from a user (302) of the system. The computational resources may operate by searching across a network (56), or may themselves be located across the network. The system includes a query-free information retrieval system (306) that is configured to exact technical documentation contained in existing user or other technical manuals to a user investigating an apparatus having a fault through a base application (304). The user can select technical information relating to probable faults in the system. The technical documentation is provided without regard to a user request. Notably, Hart does not describe nor suggest providing error proofing directions based on the recommended repair sequence of steps in the response.

Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Horejsi nor Hart, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Horejsi with Hart, because there is no motivation to combine the references suggested in the art. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statements that it would have been obvious "to modify Horejsi with Hart in order to warn and caution the operator/repair technician, and to prevent injury to the operator, as taught by Hart" suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicants' disclosure. In re Vaeck , 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion or motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection is clearly based on a combination of teachings selected from multiple patents in an attempt to

arrive at the claimed invention. Specifically, Horejsi is cited for its teaching of a graphical environment which aids in the diagnosis and repair of defects and Hart is merely cited for its teaching of warnings and cautions. Since there is no teaching nor suggestion in the cited art for the combination, the Section 103 rejection is clearly based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection be withdrawn.

Moreover, if art "teaches away" from a claimed invention, such a teaching supports the non-obviousness of the invention. U.S. v. Adams, 148 USPQ 479 (1966); Gillette Co. v. S.C. Johnson & Son, Inc., 16 USPQ2d 1923, 1927 (Fed. Cir. 1990). In light of this standard, it is respectfully submitted that the cited art, as a whole, is not suggestive of the presently claimed invention. Moreover, Applicants respectfully submit that Horejsi teaches away from Hart and the present invention, and as such, there is no suggestion or motivation to combine Hart with Horejsi. Specifically, Horejsi teaches an operator initiated diagnostic and repair program and, in contrast to Horejsi and the present invention, Hart describes an automatic innovation of computational resources without user intervention or request. Accordingly, Applicants respectfully submit that Hart actually teaches away from Horejsi and the present invention.

Moreover, and to the extent understood, no combination of Horejsi or Hart describes or suggests the claimed invention. Specifically, Claim 1 recites a method for distributing information concerning recommended steps for repairing a part, comprising "using a computer network to receive at a first location a request for a recommended repair sequence of steps for repairing the part, the request originating at a second location that is remote from the first location...processing, at the first location, the request to produce the recommended repair sequence of steps for repairing the part...determining the recommended repair sequence of steps and providing error proofing directions...and using the computer network to convey from the first location to the second location a response that includes the recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps included in the response."

Neither Horejsi or Hart, considered alone or in combination, describe or suggest a method for distributing information concerning recommended steps for repairing a part, wherein the method includes using a computer network to receive at a first location a request for a recommended repair sequence of steps for repairing the part, the request originating at a second location that is remote from the first location, processing, at the first location, the request to produce the recommended repair sequence of steps for repairing the part, determining the recommended repair sequence of steps and providing error proofing directions, and using the computer network to convey from the first location to the second location a response that includes the recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps included in the response. Specifically, neither Horejsi or Hart, considered alone or in combination, describe nor suggest providing error proofing directions wherein the error proofing directions based on the recommended repair sequence of steps in the response. Rather, and in contrast to the present invention, Horejsi describes a repair action in general terms without error proofing directions, and Hart describes a method for automatically providing documentation and computational resources without user intervention or request. Accordingly, for at least the reasons set forth above, Claim 1 is submitted to be patentable over Horejsi in view of Hart.

Claims 4-6 and 9 depend from independent Claim 1. When the recitations of Claims 4-6 and 9 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 4-6 and 9 likewise are patentable over Horejsi in view of Hart.

Claim 10 recites a method for distributing information concerning recommended steps for repairing a part, where in the method comprises "providing a computer network for communicating digital data between at least two locations...first conveying, using the computer network, a request for a recommended repair sequence of steps for repairing the part, the request having originated at a first location and being directed to a second location...and second conveying, in response to the request and using the computer network, a response that includes the recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps included in the

response, the response having originated at the second location and being directed to the first location."

Neither Horejsi or Hart, alone or in combination describes or suggests a method for distributing information concerning recommended steps for repairing a part, wherein the method includes providing a computer network for communicating digital data between at least two locations, first conveying, using the computer network, a request for a recommended repair sequence of steps for repairing the part, the request having originated at a first location and being directed to a second location, and second conveying, in response to the request and using the computer network, a response that includes the recommended repair sequence of steps for repairing the part and error proofing directions based on the recommended repair sequence of steps included in the response, the response having originated at the second location and being directed to the first location. Specifically, neither Horejsi or Hart, alone or in combination, describes nor suggests conveying a response that includes error proofing directions based on the recommended repair sequence of steps in the response. Rather, and in contrast to the present invention, Horejsi describes a repair action in general terms without error proofing directions, and Hart describes a method for automatically providing documentation and computational resources without user intervention or request. Accordingly, for at least the reasons set forth above, Claim 10 is submitted to be patentable over Hart.

Claims 11 and 13-15 depend from independent Claim 10. When the recitations of Claims 11 and 13-15 are considered in combination with the recitations of Claim 10, Applicants submit that dependent Claims 11 and 13-15 likewise are patentable over Horejsi in view of Hart.
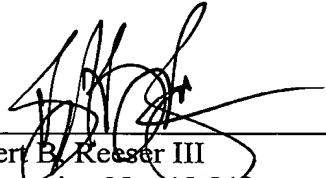
For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103 rejection of Claims 4-6, 9, 11, and 13-15 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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